REMARKS

Applicants would initially like to thank the Examiner for the courteous interview to discuss the Pending Office Action.

Claims 1, 4, and 10 have been rejected under 35 U.S.C. § 112, first paragraph, as well as under 35 U.S.C. § 132. Claims 1-9 and 19 have been rejected under 35 U.S.C. § 102 as obvious over Erickson in view of Saito or Akiyama. Claims 15-18 have been rejected under 35 U.S.C. § 103 as obvious over Erickson.

Claims 1, 2, and 4-14 are now in the application. Claims 1 and 4 have been amended. Claims 3 and 15-19 have been canceled.

Reconsideration of the rejection of pending claims and allowance of the same is therefore respectfully requested.

I.   The Examiner Interview

A. "In response to"

During the above-noted interview, the meaning of the language "in response to" was discussed. The Examiner is of the position, as set forth in the Office Action, that "in response to" requires no intervening steps. While Applicants agree that the language "in response to" includes the Examiner's definition, the language also allows for sequential steps in accordance with a domino theory. More specifically, in a system of two dominos, the second domino certainly falls "in response to" the first domino. Similarly, in a system of more than two dominos, the last will fall "in response to" the first through a series of inevitable intervening steps. This may be thought of as the second domino falling "in response to" the first, the third falling "in response to" the second, etc.

A practical example for a claim that recites that B is in response to A is a system where A activates a buffer (e.g., a timer), and expiration of the timer triggers B. In such a system, B is "in response to" A by virtue of the fact that the timer is in response to A, and B is in response to the timer.

B.   Operation of a display system

Another issue discussed during the interview is how a standard display system displays an electronic document. When the appropriate command for a display is issued by the underlying software, the document is "rendered", i.e., converted into a bit map (a collection of color commands to cause the various pixels on the video screen to display colors that form a document, but is no longer document itself). The video memory will store the bit map, and the display will continually access the video memory to maintain an image of the document on the screen. In addition, the electronic version of the document will remain in computer memory (as directed by the software application) until the occurrence of an intervening event (e.g., the user shuts off the computer). Absent such intervening event, the document exists indefinitely in computer memory.

II.   Amendments Unrelated to Patentability

Claims 1, 4, have been amended to change "displaying" to "rendering," as it is believed that "rendering" more accurately describes the corresponding portion of the method recited in claims 1 and 4 as set forth in the specification. These amendments are unrelated to patentability, such no estoppel should be deemed to attach thereto.

III.   Rejections for Formalities and New Matter

Claims 1, 4, and 10 have been rejected under 35 U.S.C. §§ 112 and 132 as indefinite and introducing new matter for use of "in response to" in these claims. The Examiner took the

position at the interview that these rejections are based on the failure of the application to disclose a responsive relationship. The rejections are respectfully traversed.

Rejected claims 1 and 4 are directed towards the document decryption side of the present invention; and both claims recite the "in response to" language. The instant application discloses an embodiment for document decryption in which "After decrypting the segment, the Application Interface 230 *immediately* discards/destroys the key, renders the decrypted segment to the screen, and then destroys the decrypted version of the segment." Page 17, lines 5-6 (*emphasis* added). For this disclosed embodiment, "immediately" applies to all the three sequential steps (destroying the key, rendering the segment, and destroying the segment), not just immediately destroying the key (to read immediately as applying only to the first step of destroying the key would be grammatically inaccurate and contrary to the scope and spirit of the invention).

As pointed out by the Examiner, the disclosure of "immediately" in the noted embodiment supports a lack of intervening steps, and thus the definition of "in response to" as viewed by the Examiner. This disclosure therefore supports the use of "in response to" as recited in claims 1 and 4.[1] Accordingly, claims 1 and 4 are fully supported by the specification. Withdrawal of the rejection of claims 1 and 4 under 35 U.S.C. §§ 112 and 132 is therefore respectfully requested.

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[1]   Applicants further note the presence of additional disclosure of the noted steps that do <u>not</u> require that the steps occur "immediately." See, *e.g.*, page 4, lines 5-10. The "in response to" language, and the scope of claims 1 and 4, is therefore consistent with the definition as discussed in Section I(A) above, and should not be interpreted to exclude intervening steps.

Claim 10 recites destroying the key and the segment "in response to" encryption. As pointed out by the Examiner in the Office Action, the application discloses an embodiment where the key and clear text are "immediately" destroyed or removed after encryption of the key. See, e.g., page 14, lines 24-29. For the same reasons as discussed above, this disclosure supports an "in response to" relationship between the encryption and the key destruction. Although, as noted above, claim 10 should not be limited to exclude intervening steps. Accordingly, the use of the "in response to" in claim 10 finds express support in the specification. Withdrawal of the rejection of claim 10 on this basis is respectfully requested.

Applicant notes that, while the Examiner has not expressly indicated the presence of allowable subject matter in claim 10, or claims 11-14 that depend therefrom, no substantive rejections have been entered against claims 10-14. Accordingly, in view of at least the foregoing, claims 10-14 are believed to be in proper form for allowance.

IV.   Substantive Rejections

The Pending Action rejects claim 1 under 35 U.S.C. § 103 as obvious over Erickson in view of Saito or Akiyama. The Examiner's rejection is respectfully traversed.

Claim 1 as amended recites rendering the accessed segment, and destroying the accessing segment in response to the rendering. The Examiner acknowledges that both Erickson and Saito fail to teach or disclose this sequence, and thus relies upon an alleged inherent disclosure of this combination of limitations in Akiyama. However, it is well settled that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. Extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference. <u>Finnigan Corp.</u>

v. International Trade Com'n, 180 F.3d 1354, 51 U.S.P.Q.2d 1001 (Fed. Cir., 1999) (emphasis added).

There is no evidence of any kind that the Akiyama device destroys an accessed segment in response to rendering the accessed segment. To the contrary, given that the typical computer/display arrangement does not destroy the accessed segment in response to rendering the segment (as discussed above), the evidence suggests that the Akiyama "display control unit." similarly does not destroy its segment in response to rendering the segment. At the very least, there is no evidence that excludes this standard operation as a possibility in Akiyama. In this absence of certainty, this limitation cannot be considered inherent to Akiyama as a matter of law.

During the Examiner interview, the Examiner argued that because Akiyama is concerned with the number of times that a decrypted document could be read, it was logical to conclude that Akiyama destroyed its decrypted segment in response to displaying the segment. Even if the Examiner is accurate, this would still only be a possibility for Akiyama's operation, not a necessity, and thus legally insufficient to support an inherency position.

Also discussed during the interview was that, following display of a segment, the segment would later be destroyed when the computer was shut down. This relationship between the display of the segment and the destruction of the segment is not "in response to" as recited in claim 1.

Accordingly, claim 1 is believed to be patentably distinct over the cited art. Withdrawal of the rejection of claim 1 and allowance of the same is therefore respectfully requested.

Claim 2, which depends from claim 1, has also been rejected under 35 U.S.C. § 103 as obvious over Erickson in view of Saito or Akiyama. In view of at least the remarks advanced in favor of claim 1, this dependent claim is likewise believed to be patentably distinct over the cited

art. Withdrawal of the rejection of claim 2 and allowance of the same is therefore respectfully requested.

The Pending Action rejects claim 4 under 35 U.S.C. § 103 as obvious over Erickson in view of Saito or Akiyama. The Examiner's rejection is respectfully traversed. Similar to claim 1, claim 4 recites destroying a decrypted segment in response to rendering the decrypted segment. As discussed with respect to claim 1, the cited references fail to teach or suggest this limitation. Withdrawal of the rejection of claim 4 and allowance of the same is therefore respectfully requested.

Claims 5-10, which depend from claim 4, have also been rejected under 35 U.S.C. § 103 as obvious over Erickson in view of Saito or Akiyama. In view of at least the remarks advanced in favor of claim 4, these dependent claims are likewise believed to be patentably distinct over the cited art. Withdrawal of the rejection of claims 5-10 and allowance of the same is therefore respectfully requested.

Claims 3 and 15-19 have been canceled, thereby rendering the rejections thereof moot. Applicants intend to pursue the patentability of these claims in a separate application, such that no estoppel should be deemed to attach to the cancellation of the claims herein.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment.

In view of the foregoing, the application is now believed to be in proper form for allowance, and a notice to that effect is earnestly solicited.
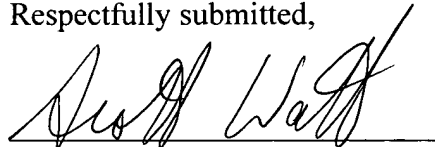
Please note that any amendments to the claims which have been made in this amendment, that have not been specifically noted to overcome a rejection based upon the prior art should be

considered to have been made for a purpose unrelated to patentability, and no estoppel should be

deemed to attach thereto.

If a telephone conference would be of value, the Examiner is requested to call the

undersigned attorney at the number listed below.

Should an extension of time be necessary to maintain the pendency of this application,

the Commissioner is hereby authorized to charge any additional extension fee to Deposit

Account No. 19-4293.

Respectfully submitted,

Scott D. Watkins
Reg. No. 36,715

Date: April 10, 2001
Steptoe & Johnson LLP
1330 Conn. Ave., N.W.
Washington, DC 20036
(202) 429-6439

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claims 3 and 15-19 have been cancelled.

Claims 1 and 4 have been amended as follows:

1. (Twice Amended) A method of controlling distribution of electronic information, comprising:

retrieving, at a user location, a segment of encrypted electronic information;

receiving, from a key server, a copy of a decryption key for the segment, and at least one
user limitation assigned to the segment and associated with the decryption key;

accessing the segment using the copy of the decryption key at the user location for the
segment and a control process, the control process responsive to a user limitation
to control distribution of the electronic information;

destroying the copy of the decryption key at the user location in response to said
accessing;

[displaying] rendering the decrypted segment in response to said accessing; and

destroying the decrypted segment in response to said [displaying] rendering.

4. A method of viewing encrypted electronic information on a display, comprising:

retrieving, at a user location, a segment of encrypted electronic information;

receiving, from a remote server, a decryption key for the segment;

decrypting the segment using the decryption key;

destroying, at the user location, the decryption key in response to said decrypting;

[displaying] rendering the segment as decrypted [on the display]; and

destroying, at the user location, the segment as decrypted in response to said [displaying]
rendering.